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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,225	01/29/2002	James W. Falciglia	01082-010006	5655
26171      7590      11/14/2003				
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500				
EXAMINER NGUYEN, CHAU N				
ART UNIT 2831		PAPER NUMBER		

DATE MAILED: 11/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/058,225	FALCIGLIA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Chau N Nguyen	2831	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 45-48 and 52-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-48 and 52-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>5&amp;6</u> . | 6) <input type="checkbox"/> Other: _____                                    |

***Reissue Applications***

***Claim Objections***

1. Claim 59 is objected to because of the following informalities: in claim 59, line 2, change "the" to --an-- and line 3, change "an", first occurrence, to --the--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35

U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35

U.S.C. 103(a).

4. Claims 45-48, 52-57, 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waterman (769,366) in view of GB 1,117,862 (GB'862).

5. Waterman discloses a conductive sheath and an inherent method, comprising forming a length of overlapping, helically wound conductive sheath, the conductive sheath (Figs 1-3) having an outer surface having an appearance. Waterman does not disclose after the forming, applying a coating to the outer surface of the sheath, the coating having an appearance different from the appearance of the outer surface of the sheath, nor the sheath being used for housing conductors. GB'862 discloses a conductive sheath (4) having an appearance and a coating (5) having an appearance different from the appearance of the outer surface of the sheath. It would have been obvious to one skilled in the art to modify the conductive sheath of Waterman by applying, after the forming, a coating (5) as taught by GB'862 on the outer surface of the sheath to provide a distinguishing mark on the cable. It would also have been obvious to one skilled in the art to use the conductive sheath of Waterman for housing conductors since the sheath of Waterman is flexible and since using a conductive sheath for housing conductors is known in the art. In addition, it has been held that a recitation of the intended use

of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963) (re claims 45, 52, 60).

The modified sheath of Waterman (see GB'862, Figs 1-4) also discloses the coating being continuous along at least a portion of the sheath (re claims 46, 53), the coating being continuous around the circumference of the sheath (re claims 47, 54), the coating permitting electrical conductivity between successive windings of the sheath (i.e., the successive windings of Waterman are interlocked before the coating being applied, therefore the successive windings are still in electrical contact after the coating being applied) (re claims 48, 55), the outer surface of the sheath being provided with alternating crowns and valleys along the length of the sheath (re claim 56), the crowns and valleys forming a helical configuration on the outer surface of the sheath (re claim 57), and no further process being performed that would cover the applied coating (re claim 59).

6. Claims 52 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brorein (4,154,976) in view of GB'862.

Brorein discloses a conductive sheath and an inherent method, comprising forming a length of continuous conductive tubular sheath (18) for housing conductors, wherein the conductive sheath has an outer surface having an appearance and being smooth along the length of the sheath (re claim 58). Brorein does not disclose after the forming, applying a coating to the outer surface of the sheath, the coating having an appearance different from the appearance of the outer surface of the sheath (re claim 52). GB'862 discloses a conductive sheath (4) having an appearance and a coating (5) having an appearance different from the appearance of the outer surface of the sheath. It would have been obvious to one skilled in the art to modify the conductive sheath of Brorein by applying, after the forming, a coating (5) as taught by GB'862 on the outer surface of the sheath to provide a distinguishing mark on the cable.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 45, 52, 59 and 60 have been considered but are moot in view of the new ground(s) of rejection except for the following.

Applicant argues that GB'862 (or UK'862) teaches placing a distinguishing marker underneath a helical metal tape. There is no description or suggestion in GB'862 of placing the distinguishing marker on the outer surface of a sheath. This argument is not found persuasive because GB'862 does teach providing the distinguishing marker (5) on an outer surface of the sheath (4) which is a helical conductive sheath. In response to applicant's argument that there is no suggestion to combine the Brerein and GB'862 references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to do so is found in the references themselves. Specifically, GB'862 does teach providing a coating having a difference appearance from the outer surface of a conductive sheath to provide a distinguishing marker on the sheath.

### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 308-0693. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308 3682. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Chau N Nguyen  
Primary Examiner  
Art Unit 2831